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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,136	12/29/2000	Gary L. Shanklin	659/764	1796

757 7590 08/12/2003

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EXAMINER

HOWARD, SHARON LEE

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 08/12/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,136

Applicant(s)

SHANKLIN ET AL.

Examiner

Sharon L. Howard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/13/02, 2/12/03, 4/30/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10-18 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-18 and 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

In view of the papers filed on 4/30/03, the finality of that action is withdrawn.

Receipt of associate power of attorney and supplemental prior art with attachment filed on 12/13/02, request for one month extension of time and appeal filed on 2/12/03, and the request for one month extension of time and appeal brief filed on 4/30/03 have been acknowledged.

Claims 1-5,10-18,23-29 are pending.

DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5,14,16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Siegfried et al. (U.S. Patent No. 5,989,527).

Siegfried teaches topical compositions comprising polyesters which include a backbone derived from the reaction of a diol and a diacid (col.3, lines 63-67, bridging col.4, lines 1-58). Siegfried teaches that the diacid include adipic acid or glutaric acid (col.5, line 11). Siegfried generically teaches that any alkane diol (col.5, line 38-46) is used to form the polyester, and Siegfried also generically teaches hydroxy-functional polyester diols (col.7, lines 8-10). Siegfried teaches organic acids such as citric acid, malic acid (col.10, lines 49-56). Siegfried teaches other ingredients such as emulsifiers and emollients (col.12, line 28).

Siegfried teaches that in preparing said composition, the composition may be in the form of a cream or a lotion (col.12, lines 52-65).

The prior art meets the claims of the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5,14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegfried ('527).

Siegfried is applied above.

Siegfried does not particularly teach the specific amount of the acid.

However, Siegfried teaches that the amount of acid to be used, in equivalent weight, is determined according to the number of -OH or ---COOH groups, or equivalents, to be provided per unit mass of polymer (col.4, lines 59-62).

The expected result would be a lotion composition comprising a polyester and an organic acid.

It would have been within the skill of the ordinary practitioner at the time the invention was made to use the teachings of Siegfried. One having ordinary skill in the art would have been motivated to determine the particular amount of the acid by routine experimentation, and one would have been motivated to prepare the composition of

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Siegfried, because Siegfried teaches topical compositions which comprises an organic acid and a polyester in the form of a lotion. One would expect to achieve similar results.

Claims 1-5,10-18,23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegfried ('527) in combination with Luu et al. (U.S. Patent No. 5,871,763).

Siegfried is applied above.

Siegfried does not particularly teach a surfactant.

However, Luu teaches a tissue product treated with a lotion composition, which provides a smooth feel, that is nongreasy, lubricious and is a solid at ambient temperature (see abstract). Luu teaches that the lotion composition comprises a cationic surfactant (col.8, lines 63-67), from about 5% to about 75% of an emollient (col.7, lines 33-67, bridging col.8, lines 1-62), and from about 0.025% to about 5% of anti-viral agent consisting of glutaric, citric and succinic acid (col.10, lines 9 and 10).

Both references teach a lotion composition comprising an organic acid and an emollient. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. (See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

The expected result would be a lotion composition comprising a polyester, an organic acid, a polyester and a surfactant.

One having ordinary skill in the art would have been motivated to prepare a third composition by including a surfactant into the composition of Siegfried, because a third

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composition can be used for the same purpose of treating a substrate with a lotion composition which is non-greasy and smooth feeling.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Howard whose telephone number is (703) 308-4359. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3121 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Sharon Howard
August 5, 2003



THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
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